

REMARKS

Claims 1-86 are pending in this application. The Examiner has required restriction under 35 U.S.C. §121 to one of the following two Groups of claims:

- (a) Group I, claims 1-20 and 48-62; and
- (b) Group II, claims 21-47 and 63-86.

In compliance with the restriction requirement, Applicants provisionally elect to prosecute the claims of Group II (i.e., claims 21-47 and 63-86). This election is made with traverse. For the reasons set forth below, Applicants respectfully submit that all of the claims 1-86 are properly set forth for examination in the present application as filed. Accordingly, Applicants request reconsideration and withdrawal of the restriction requirement.

In the Office Action, the Examiner contends that the inventions claimed in Groups I and II are related as subcombinations disclosed as usable together in a single combination. Such restriction is proper only when there would be a serious burden if restriction were not required, “*as evidenced by separate classification, status or field of search.*” MPEP §806.05(d) (emphasis added). Applicants respectfully submit that a *prima facie* case for restriction has not been made as the Office Action does not present any such required evidence of separate classification, status or field of search. Withdrawal of the restriction requirement is warranted on this basis alone.

Moreover, generally speaking, the claims of restricted Groups I and II variously cover embodiments of methods and systems for determining the prospective profitability and productivity of licensed professionals based at least in part on aggregated data from various sources. Applicants respectfully submit that the relationship between the claims of these restricted Groups also warrants the withdrawal of the restriction requirement under MPEP

§806.05(c), (d). It is submitted that the examination in the same application of the claims in Groups I and II would not impose an undue search burden -- a single search can be performed for all claims. That is, a search of the prior art during examination of the elected claims of Group II would, at the same time, result in a search of the prior art with respect to the non-elected claims of Group I. Consequently, to require Applicants to file one or more separate divisional applications directed to the non-elected Group I claims would necessitate that the very same search be repeated at a later date. Such redundant searching is inefficient and, as such, inimical to the stated operational goals of the PTO.

Further still, the restriction requirement imposes added burden and costs to the Applicants who must file one or more separate divisional applications in order to prosecute the non-elected claims. Also, because the term of a patent is twenty years measured from its effective filing date, the delay in the examination of the non-elected claims will likely result in the patent term for these claims being unnecessarily curtailed.

On the basis of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the restriction requirement.

Early and favorable examination on the merits is earnestly solicited. The Examiner is invited to contact Applicants' undersigned attorney at the telephone number set forth below if it will advance the prosecution of this case.

No fee is believed due. Please charge any fee deficiency to the undersigned attorneys' Deposit Account No. 50-0540.

Respectfully submitted,

By: 

Richard L. Moss, Esq.

Registration No. 39,782

Attorneys for Applicants

KRAMER LEVIN NAFTALIS & FRANKEL LLP

1177 Avenue of the Americas

New York, New York 10036

(212) 715-9100